



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,784	09/01/2000	Franciscus Cornelis Caris	US 000220	5607

7590 10/03/2003

U S Philips Corporation
580 White Plains Road
Tarrytown, NY 10591

EXAMINER

PRIETO, BEATRIZ

ART UNIT	PAPER NUMBER
----------	--------------

2142

DATE MAILED: 10/03/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/653,784

Applicant(s)

CARIS ET AL.

Examiner

B. Prieto

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- ✓ 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- ✓ 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- ✓ 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ✓ 1) ☒ Notice of References Cited (PTO-892)
- ✓ 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ✓ 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4-6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This communication is in response to Application No. 09/653,784 filed 09/01/00, claims 1-17 remain pending and are hereby set forth for examination.
2. Drawings have been objected to by the Draftsperson under 37 CFR 1.84 or 1.152, correction noted on PTO-948 is required. A proposed drawing correction or corrected drawings are required in reply to this office action to avoid abandonment of the application. The objections to the drawings are no longer held in abeyance. If reply does not include corrected drawings, proposed corrections, or reply to the drawings requirement, the reply would be held non-responsive (See MPEP §1.85 revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000).

Specification Objection

3. An applicant making a claim for priority for provisional application under 35 USC for continuity under 35 USC 120 is no longer required to include the claim in the oath/declaration. Applicant must comply with 37 CFR 1.78 which requires, in part, that the priority claim information be either in the first line of the specification following the title or in an application data sheet (ADS) (§1.76) (see MPEP 202.01).

Claim Objections

4. Claims 1, 6, 7, 11, 12 and 16 are objected to because of the following minor informality: where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line *indentation*. There may be plural indentations to further segregate subcombinations or related steps (see 37 CFR 1.75(i) and MPEP 608.01(m)).
5. Claim 3 recites the clause "the device" in the first and second line of this claim. There is insufficient antecedent basis for this limitation in the claim.
Claim 6 recites the clause "the appliance" on the second and third line of this claim, being the claim 6 depended on claim 4, which recites a "further appliance". There is insufficient antecedent basis for this limitation in the claim. For the purposes of examination the appliance recitation on claim 6 refers to the "further appliance".

Claim 7 recites the clause "the appliance" in the second, fourth and sixth line of this claim. There is insufficient antecedent basis for this limitation in the claim. Claims dependent claim 7, such as 8, 9 and 10 having a "the appliance" recitation thereby, also lack antecedent basis.

Claim 11 recites the clause "the equipment" in the second and fourth line of this claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 13 recites the clause "the remote" in the first line of this claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 15 recites the clause "the equipment" in the second line of this claim. There is insufficient antecedent basis for this limitation in the claim. Correction is required (see MPEP 2173.05(e)).

6. Claims 11 and 15 are objected to because of the following informalities: use of acronyms in the claim language. In this case, "CE" is a non-obvious acronym, applicant is required to spell this out according to supportive disclosure.

Claim Rejection 35 U.S.C. §102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1-17 are rejected under 35 U.S.C. 102(e) as being anticipated by ALLPORT U.S. Patent No. 6,104,334.

Regarding claim 1, Allport teaches substantial features of the invention as claimed, teaching a system/method and software implementation (col 7/lines 49-52) including a remote control for controlling various appliance, wherein the remote control is programmable by a consumer (abstract), wherein the appliances are Internet connectable (col 9/lines 63-65), the method comprising,

enabling connecting the appliance to a server on the Internet in response to the consumer controlling the remote control device (Allport: actuating buttons on a remote control for downloading data into the remote control from a source (i.e. connected) on the Internet using a third party e.g. a PC ("appliance"), col 8/lines 30-57, or using another device display e.g. web browser ("appliance"), col 9/lines 63-65, access to web sites (i.e. connects) using the remote control, col 4/lines 62-65); and

enabling the server to download to the appliance data representative of a control code for being programmed into the remote control device via the appliance (Allport: downloading device configuration data or libraries see col 5/lines 50-67, downloading into remote control see col 4/lines 52-57, gather programmable data see col 5/lines 50-67, download via third party appliance see col 8/lines 30-53).

Regarding claim 2, enabling the consumer to manipulate the data prior to the data being programmed into the remote control device (Allport: scroll or select, i.e. "manipulate" data see col 15/lines 5-26, user selects and then download see col 8/lines 30-57, scroll through sources see col 14/lines 17-20, via remote controller or third party appliance display see prior to downloading col 8/lines 30-46).

Regarding claim 3, enabling to program the remote control device via a wireless connection between the appliance and the remote control device (Allport: programming a remote control, where the appliance and remote control communicate via an infrared (IR) connection see col 5/lines 66-col 6/line 13, wireless, or CEBus connection i.e. a networking electronic consumer standard which includes e.g. infrared light see col 4/lines 36-39).

Regarding claim 4, enabling the consumer to notify the server, through the appliance of equipment for which to download the control code (Allport: download upon request, request including user selected data to be downloaded "informing" to source what data to download see col 15/lines 5-26, data such as control code of wide variety such as configuration information or command libraries to be downloaded for controlling different devices, i.e. equipments where the server is contacted via a third party appliance see col 5/lines 5-67).

Regarding claim 5, the equipment comprises a further appliance (Allport: appliances see col 9/lines 21-28, devices to be controlled see col 9/lines 63-65).

Regarding claim 6, further including:

the equipment comprises the appliance (Allport: devices to be controlled e.g. TV, CD see col 50-col 6/line 21, other devices to be controlled see col 4/lines 5-10); and

the control code relates to a functionality of the appliance (Allport: control code of wide variety such as configuration information or command libraries to be downloaded for controlling different devices, i.e. equipments see col 5/lines 5-67).

Regarding claim 7,

the remote control device is programmable (Allport: abstract, col 44/lines 44-33) ;

the remote control device has a button (Allport: keyboard for programming see col 8/lines 30-57, including soft or hard buttons for user selections see col 10/lines 27-67, including for downloading software into the remote control see col 8/lines 30-57) for causing the third party appliance to connect to a server on the Internet supporting download of data therewith, (Allport: remote control controls an appliance e.g. browser-enabled TV see col 9/lines 63-65) and downloading programming information and storing into the remote control over an established connection to support receipt of data to be stored into the remote control's memory) (Allport: col 8/lines 30-57);

the appliance is capable of programming the remote control device based on data received from the ("specific") server via third party software on the appliance (e.g. web-enable TV or PC) (Allport: col 8/lines 30-57 and col 9/lines 63-65).

Regarding claim 8, wherein the appliance allows a user to manipulate the data prior to programming the remote control device (Allport: scroll or select, i.e. "manipulate" data see col 15/lines 5-26, select and then download see col 8/lines 30-57, scroll through sources of data see col 14/lines 17-20, via remote controller or third party display see col 8/lines 30-46).

Regarding claim 9, wherein the appliance and the remote control device communicate via a wireless connection for programming (Allport: appliance-device wireless connection, col 5/lines 66-col 6/line 13, col 4/lines 36-39, and remote controlled programmed via third party appliance e.g. PC or web enabled TV col 8/lines 30-57 and col 9/lines 63-65).

Regarding claim 10, wherein the appliance comprises a set top box (Allport: devices to controlled include cable box coupled to TV, col 8/lines 58-67).

Regarding claim 11:

enabling a user of ("CE") equipment to specify to a server on a data network information about the equipment (Allport: user sending a request for data for programming data on an equipment to a server for downloading requested data see col 8/lines 30-53, information selectable and specific to an equipment see col 5/lines 50-65);

enabling to program via the data network remote user control of the equipment according to the information (Allport: configuration information and libraries to program remote controller for controlling devices via a data network e.g. the Internet see col 5/lines 50-65) and

storing the information in the customer base (Allport: storing downloading information at the remote controller memory storage "customer base" see col 8/lines 52-57, remote controller having storage means see col 7/lines 56-60).

Regarding claim 12:

supplying a remote control device that is pre-programmed for use with a set top box (Allport: prior art remote controller are pre-programmed for controlling appliances, see col 1/lines 38-45 for controlling appliances including cable boxes, see col 8/lines 58-67);

the method is used for subsidizing the set top box (Allport: method is an improvement or aid i.e. subsidize over the prior art, see col 3/lines 52-60).

Regarding claim 13, comprising supplying the remote control device (Allport: Fig. 2, col 9/lines 6-9).

Regarding claim 14, enabling to use the storage ("customer base") to provide a user-selectable ("customized") service to the user (Allport: user-selectable configuration col 5/lines 50-65 for controlling a plurality of devices by storing downloaded configurable programs col 8/lines 52-57 and col 7/lines 56-60).

Regarding claim 15, programming via the data network a remote control used for controlling a plurality of appliances (Allport: downloading program over a data network e.g. the Internet to the remote control's memory, see col 8/lines 3-57, program configure the remote control to control a plurality of appliances, see col 5/lines 50-67).

Regarding claim 16, the limitations of this claim are substantially the same as the limitation of claim 1, same rationale of rejection is applicable.

Regarding claim 17,

a look-up table that is programmable with data downloaded from a server on the Internet (Allport: a data structure or memory structure ("lookup table") that is programmable or loadable with programs downloaded from a server on the Internet, see col 8/lines 30-57, remote control with storage capabilities, see col 7/lines 56-60, data downloaded for programming remote control, see col 5/lines 50-67);

the look-up table maps a first control code, received from a remote control device, onto a second control code for control of an apparatus via the appliance (Allport: downloadable programs are specific to each the appliance from the plurality of appliances the remote control is to control, therefore the programs (i.e. "control codes") each correlated ("are mapped") to a specific apparatus to be controlled, see col 8/lines 50-66, wherein received at the remote control device via an appliance having a third part software, e.g. PC or web browser, col 9/lines 58-65, col 8/lines 30-40 or e.g. to control a TV apparatus via a web browser appliance).

Pertinent Prior Art:

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure; pertinence is presented in accordance with MPEP§ 707.05. Copies of documents cited will be provided as set forth in MPEP§ 707.05(a):

U.S. 5,790,753 (08-1998)

Krishnamoorthy et. al. a system/method including a programmable remote control, the system including a customer premises 140 including a client computer, in the form of a disk-less set-top box (STB) 700, a display device, e.g., a television (TV) 141, and a remote controller (R) 142 where the servers 110 and 120 also maintain software programs to operate the STB 700 downloadable as software programs to the STB 700. A user makes a request using the remote control device 142, and the set-top box 700 executing boot software in response to the request, thereby establishing a connection between a server and the STB 700 creating a bi-directional channel path 133, user sends command over the control channel for download software programs into the STB 700 (col 3/lines 29-55, col 5/lines 37-60, col 6/lines 6-21).

U.S. 6,493,688 B1 (12-2002)

DAS et. al. teach a system/method including a programmable remote control, the system including a remote control for controlling such a TV or STB loaded with software modules; where the software could be built into the remote control or downloaded at regular intervals via a PC or STB (col 5/lines 60-col 6/line 37).

U.S. 5,544,161 (8-1996)

BIGHAM et. al. teach a system/method including a programmable remote control, further including a set-top box (24), a remote control and/or keypad to receive various selection signals from a user, which are relayed by the set-top via an upstream communication channel in response to user's input; wherein upon the actuation of a button by the user on the remote control after turning on the set-top box, the set-top box establishes a connection with a control channel broadcasting navigation software from a service provider and captured by the set-top box (col 25/lines 16-36 and col 25/lines 37-45).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (703) 305-0750. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Mark R. Powell can be reached on (703) 305-9703. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-6606. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

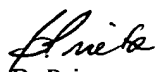
or faxed to the Central Fax Office:

(703) 872-9306, for Official communications and entry;

Or Telephone:

(703) 306-5631 for TC 2100 Customer Service Office.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Fourth Floor (Receptionist), further ensuring that a receipt is provided stamped "TC 2100".


B. Prieto
Patent Examiner
September 28, 2003